

### **REMARKS**

The Non-Final Office Action mailed July 6, 2010 has been received and carefully considered. Claims 1-23, 25-50, and 52-70 are pending in the application. No new matter has been added. Claims have been cancelled as indicated above without waiver or disclaimer. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks.<sup>1</sup>

#### **Rejection of Claims 1, 25, 50, 59, and 61 under 35 U.S.C. § 112, ¶ 2**

On pages 2-3 of the Office Action, claims 1, 25, 50, 59, and 61 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. Applicant respectfully traverses this rejection.

The Office alleges that the claims “are system claims but appear to have limitation directed to both a system and method claims thus appearing to be hybrid claims.” Office Action, p. 3. Applicant respectfully disagrees. The claims are system claims as shown by the both the preamble and the recited structure in each claim, e.g., in claim 1, “a remote station,” “a database,” and “a database server.” The Office refers to several of the wherein clauses in the claim as being method steps, however these elements are recitations of the functions performed by the recited structure. For example, claim 1 recites, *inter alia*, “wherein the database server stores such new candidate code in the database.” The element recites the structure and the function performs.

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<sup>1</sup> As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

The Office alleges that “the content serves only to define the products not to the structure of the station” on page 2 of the Office Action. Applicant respectfully submits that this is incorrect. The claim recites apparatus structure, such as “a remote station” in the preamble, uses the term “comprising” in the transition, and further recites structure in the claim body associated with the remote station. Accordingly, the claim is an apparatus or system claim. The claim then recites the elements of the system and the functions they perform. Hence, the structure is defined by the elements of the claim.

Applicant submits that the present § 112, ¶ 2 rejection is improper and Applicant respectfully requests the withdrawal thereof.

**Rejection of Claims 1-23, 25-50, 52, 54-60, and 70 under 35 U.S.C. 102(e)**

Claims 1-23, 25-50, 52, 54-60, and 70 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,405,175 to Ng (“Ng”). Applicant respectfully traverses this rejection.

It is well understood that for a proper anticipation rejection, all claim limitations must be taught or suggested by the prior art and the claim elements must be arranged or combined in the same way as recited in the claim. This baseline standard for anticipation under 35 U.S.C. §102 was reiterated by the Federal Circuit in *Net Moneyin v. Verisign*, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), holding:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and

combining various disclosures not directly related to each other by the teachings of the cited reference.” *Sanofi-Synthelabo v. Apotex, Inc.*, 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting *In re Arkley*, 172 USPQ 524 (CCPA 1972)).

In order to maintain an anticipatory rejection under 35 U.S.C. §102, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

*Ng Fails to Anticipate Independent Claim 1*

At the outset, Applicant notes that the Office has, in the present alleged rejection, combined the elements of independent claims 1, 25, 44, 50, 59, 60, and 70 into the same rejection, failing to differentiate between the elements of the system claims and the steps of the method claims, rather than providing a specific rejection for each element of each claim. However, Applicant will respond to the rejections as best understood.

Ng discloses “a searchable database [that] contains information submitted by rewarded users.” Col. 3, lines 23-24. Ng’s database contains product information, such as price. See, e.g. Fig. 4. Ng also discloses that users with accounts can earn rewards for using Ng’s database. See, e.g. col. 7, lines 61-67. As such, Ng fails to “teach[] a method for tracking promotion of at least on [*sic*] group of products” as alleged by the Office on page 3 of the Office Action.

Claim 1 recites, *inter alia*:

the database server configured to issue a credit certificate to the account of the user upon a pre-set value of non-zero valuation credits being accumulated in the

user account, wherein the credit certificate is usable as a coupon, rebate, or refund by the user and the user is notified of the pre-set value being accumulated.

Applicant respectfully submits that Ng fails to disclose this element. Ng, as mentioned above, discloses rewards. Ng's rewards "can later be converted into prizes." Col. 9, lines 25-26. Ng discloses that a user is notified of points rewarded for performing actions such as entry of information into Ng's system. See col. 10, lines 8-14. However, Ng fails to disclose that *a credit certificate* is issued to the user account *upon a pre-set value of non-zero valuation credits being accumulated* and that the user is *notified of the pre-set value being accumulated*. Indeed, Ng fails to disclose that any *pre-set values* for issuance or redemption of any accumulated rewards. Therefore, Ng fails to disclose this element.

Ng discloses in its background section that:

Consumer rewards programs have been widely used for many years. Supermarkets once issued value stamps or coupons that a consumer could accumulate and exchange for a reward or discount. Airline Frequent-Flyer programs reward travelers with free tickets once enough miles have been flown. Credit-card-like rewards cards are presented by shoppers at supermarket checkouts to receive instant price reductions. Col. 1, lines 15-22.

This disclosure, while disclosing certain prior art reward programs as interpreted by Ng, fails to disclose at least *notifying the user of the pre-set value*. Further, the frequent flyer programs disclosed are stated to issue "free tickets," which Applicant submits differ from the recited *credit certificate*. Also, the value stamps and credit-like rewards cards disclosed by Ng fail to associate those rewards with a *pre-set value* as recited by the claimed embodiments.

Applicant notes that since this disclosure is in the background of Ng, this would have to be combined with Ng's disclosed embodiments since it is not directly related to Ng's invention and is described separately. Therefore, one of ordinary skill in the art would have to improperly pick, choose, and combine this disclosure with the remainder of Ng's disclosure regarding Ng's

embodiments. This violates the anticipation standard for a reference. See, e.g., Sanofi-Synthelabo, 89 USPQ2d at 1375.

Therefore, in view of the preceding remarks, the Examiner has failed to present a *prima facie* case of anticipation for at least independent claim 1. Applicant respectfully requests the withdrawal of the anticipation rejection of claim 1.

Independent claims 25, 44, and 59, although differing in scope, recite similar elements to independent claim 1, and are therefore allowable for at least the reasons given for independent claim 1 above.

*The Dependent Claims Are Allowable*

Dependent claims 28-38, 44-49, and 54-58 depend from one of independent claims 25, 44, and 50, and thus incorporate all the elements of the respective independent claims and are therefore allowable for at least the reasons set forth above.

**Rejection of Claims 18 and 61-69 under 35 U.S.C. 103(a)**

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng in view of U.S. Patent No. 5,895,075 to Edwards (“Edwards”). Claims 61-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ng in view of U.S. Patent No. 5,623,547 to Jones (“Jones”). Applicant respectfully traverses these rejections.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-

18 (1966); see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.* Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

*Dependent Claim 18 is Patentable over Ng in View of Edwards*

Dependent claim 18 depends from independent claim 1. Accordingly, claim 18 is allowable at least based on this dependency. Furthermore, Applicant respectfully submits that the secondary reference of Edwards fails to cure the deficiencies of Ng as described above. Therefore, claim 18 is allowable over the cited art and Applicant respectfully requests the withdrawal of the rejection.

*Independent Claim 61 is Patentable over Ng in View of Jones*

Independent claim 61 recites, *inter alia*:

wherein further the user can transfer value from the at least one account associated with the user to at least one account belonging to a second user of the front end service.

The Office, on page 14 of the Office Action, admits that Ng fails to disclose at least this element. The Office relies upon Jones as allegedly curing this deficiency of Ng. Applicant respectfully disagrees.

Jones' disclosure is related to cashless transaction systems, such as credit and debit cards. Jones discloses a "value transfer system which allows value to be transferred between electronic purses." Abstract. Jones discloses the transfer of funds from a user to a retailer. See col. 1, lines 14-19. However, Jones fails to disclose transferring value from *the user* to an account of a *second user of the front end service*. First, the retailer of Jones is not a second user of the front end service. The retailer is a different entity from the user in Jones. As shown by the plain language of the claim, the user and the second user are similar entities and both have accounts. Jones' disclosure refers to payment from a customer to a retailer, such as in a credit transaction. Indeed, Jones disclosure is focused on such transfers, not transfers between *users* who have *accounts* associated with the system. One of ordinary skill in the art would appreciate a user and a retailer to be different from the *user* and the *second user* of recited claim. The Office is failing to consider the claim as a whole in accordance with basic obviousness principles. See MPEP § 2142.02(I) and (II)

Therefore, Applicant respectfully submits that the combination of Ng and Jones fails to render at least claim 61 obvious. Applicant respectfully requests that the rejection be withdrawn.

*Dependent Claims 62-69 Are Allowable*

Dependent claims 62-69 depend from claim 61, and thus incorporate all the elements of the independent claim and are therefore allowable for at least the reasons set forth above.

**CONCLUSION**

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date:

9/15/10



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